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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------|-------------|----------------------|---------------------|------------------|
| 10/697,710 | 10/30/2003 | Juan P. Renteria | JRPIPE.002A | 8351 |
| 20995 | 7590 | 02/25/2005 | EXAMINER | |
| KNOBBE MARTENS OLSON & BEAR LLP | | | HOOK, JAMES F | |
| 2040 MAIN STREET | | | ART UNIT | |
| FOURTEENTH FLOOR | | | PAPER NUMBER | |
| IRVINE, CA 92614 | | | 3754 | |

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/697,710 | Applicant(s) RENTERIA, JUAN P. | |
| | Examiner James F. Hook | Art Unit 3754 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3-31-04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Renaud. The patent to Renaud discloses the recited apparatus for installing a sheet of pipe liner inside a large sized pipe which is a man entry sized pipe, comprising a form 50 having an exterior surface adapted to position a sheet of pipe liner or membrane 60 adjacent an inner wall of the pipe C1 to be lined, the exterior surface conforms to the contours of the inner walls, air can be provided to expand the membrane 60 which inherently would create a pocket of air or air cushion between the membrane and the form thereby inherently reducing friction between the membrane and form, where the apparatus can be moved vertically along the pipe to be lined and therefore is extended and retracted along the vertical direction (see figures 5 and 6).

Claims 6-10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by O'ffill. The patent to O'ffill discloses the recited an apparatus for installing a pipe liner 10 inside a sewage pipe having first cross sectional configuration, a form 42 having at least one movable surface which can be extended in a horizontal manner and is formed of a plurality of moving hinged sections that move from a first position to a second position placing the liner in a position substantially adjacent the inner wall and proved

with an injection system for a carrier material 36 which can include adhesives and grout, where such is injected between the liner and the pipe inner wall, the movable sections of the form define the movable surface of the form, the curved sections are hinged together to expand outward, the shape of the movable surface in the second expanded condition conforms substantially the same as the cross section of the inner walls of the pipe, such forms a hemispherical shape, and an actuation system in the form of pneumatic pistons is provided to move the movable surface between the first and second positions.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Renaud in view of O'ffill. The patent to Renaud discloses all of the recited structure with the exception of suggesting horizontal movement in the form and making the form of pivoted side walls in combination with an upper portion. The patent to O'ffill discloses the structure above, and it would have been obvious to one skilled in the art to modify the form in Renaud to be formed of a plurality of hinged sections to allow such to move in a horizontal manner and displace the liner toward the wall as allow the form to fit easier into the pipe and prevent contact with the inner pipe wall until such was required for the repair as suggested by O'ffill, where such would prevent failure at install which

would weaken the final product and require early replacement thereby saving repair costs in the future.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Renaud in view of Thompson. The patent to Renaud discloses all of the recited structure with the exception of providing a plurality of pipes and air openings in the form. The patent to Thompson discloses that it is old and known in the art to provide a plurality of feed pipe to feed air for inflation of an expandable layer of a form 10. It would have been obvious to one skilled in the art to provide more than one feed pipe to feed air to various portions of the inflatable member of Renaud as suggested by Thompson where such is merely a duplication of parts and would allow for more even pressure which would insure proper adherence of the liner to the pipe thereby saving money in early replacement costs.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'ffill in view of Renaud. The patent to O'ffill discloses all of the recited structure with the exception of providing an air cushion between the liner and the form. The patent to Renaud discloses the recited structure above, and it would have been obvious to one skilled in the art to provide the form in O'ffill with an air injection system to help expand the liner into contact with the inside of the pipe to be lined as suggested by Renaud, where such would insure a better seal between the adhesive, pipe wall, and liner thereby saving early replacement costs due to failure from an improper seal.

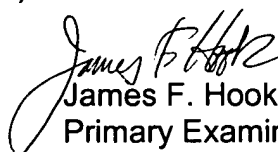
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Baviello, Sr., Parkes, Rice, Gilleland (532 and 215), Warmerdam, and Harrington disclosing state of the art pipe repair methods and apparatus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James F. Hook whose telephone number is (571) 272-4903. The examiner can normally be reached on Monday to Wednesday, work at home Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mar can be reached on (571) 272-4906. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


James F. Hook
Primary Examiner
Art Unit 3754

JFH